

REMARKS-General

1. The newly drafted independent claim 36 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 36-43 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of Claims 1-4 under 35USC103

2. The Examiner rejected claims 1-4 over Jones (US 5,741,491) in view of Yang et al (2003). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

3. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)-(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

4. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Jones which is qualified as prior art of the instant invention under 35USC102 are obvious in view of Yang at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

5. The applicant respectfully submits that in order to determine whether the differences between the subject matters sought to be patent as a whole of the instant invention and the primary prior art, Jones, are obvious in view of the supplemental cited

art, Yang et al, we have to identify all the differences between the claims of the instant inventions and Jones. The applicant respectfully identifies the differences between the claims of the instant invention and Jones as follows:

(a) In claim 36, "a herbal composition comprises compositions of *Toona sinensis* and *Heracleum lanatum*" is claimed, wherein Jones merely teaches a medicinal composition for diabetes using an extracted derived from *Heracleum lanatum* and a species of *Populus* without any mention of any composition of *Toona sinensis* and *Heracleum lanatum*.

In column 2, lines 45-49, Jones discloses species of the genus *Populus* includes *Populus acuminata*, *Populus alba*, *Populus angustifolia*, *Populus balsamifera*, *Populus deltoids*, *Populus grandidentata*, *Populus heterophylla*, *Populus nigra*, *Populus sargentii*, *Populus tremuloides* and *Populus tricocarpa*. In other words, Jones is silent regarding how to combine *Heracleum lanatum* with *Toona sinensis* to form the herbal composition.

(b) In claim 36, "a herbal composition for treatment of a patient having diabetes mellitus, arthritis, and neuralgia" is claimed, wherein Jones merely teaches the medicinal composition for diabetes without any mention of any treatment for arthritis and neuralgia. The applicant respectfully submits that the composition of *Heracleum lanatum* and a species of *Populus* taught by Jones can only used for treatment of diabetes. The composition of *Toona sinensis* and *Heracleum lanatum* as disclosed by the instant invention is used for treatment of diabetes mellitus, arthritis, and neuralgia.

(c) Different medicinal compositions lead to different medicinal treatment. The applicant respectfully submits that the chemical reaction between *Heracleum lanatum* and a species of *Populus* taught by Jones is totally different from the chemical reaction between *Toona sinensis* and *Heracleum lanatum* as disclosed in the instant invention. In fact, the composition of *Toona sinensis* and *Heracleum* can compensate, complement and maximized the treatment for diabetes mellitus, arthritis, and neuralgia.

(d) Jones fails to teach "*Toona sinensis* is leaves of *Toona sinensis* and *Heracleum* is roots of *Heracleum lanatum*" as claimed in claim 37 in addition to what is claimed in claim 36 as a whole. Jones is silent regarding any use of *Toona sinensis*.

(e) Jones fails to teach “the quantity of *Toona sinensis* is not less than the quantity of *Heracleum lanatum* by weight” as claimed in claims 38 to 39 in addition to what is claimed in claim 36 as a whole.

(f) Jones fails to teach any herbal composition prepared by the claimed process as claimed in claims 40 to 43 in addition to what is claimed in claim 36 as a whole. The applicant respectfully submits the claimed process is unique for making the herbal composition including *Toona sinensis* and *Heracleum*.

6. Whether the claims 36 to 43 as amended of the instant invention are obvious depends on whether the above differences (a) to (f) between the instant invention and Jones are obvious in view of Yang et al at the time of the invention was made.

7. Furthermore, the applicant respectfully submits that when applying 35 USC 103, the following tenets of patent law must be adhered to:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (c) The references must be viewed without the benefit of hindsight vision afforded by the claimed invention; and
- (d) Reasonable expectation of success is the standard with which obviousness is determined.

Also, “The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art.” Libbey-Owens-Ford v. BOC Group, 4 USPQ 2d 1097, 1103 (DCNJ 1987).

8. Yang et al merely teaches a substance extracted from *Toona sinensis* leaves without any mention of any suggestion of how such extracted substance be possible incorporating with *Heracleum lanatum* to form the herbal composition. In other words, neither Jones nor Yang et al suggests a herbal composition of *Toona sinensis* and *Heracleum lanatum* containing the above distinctive features (a) to (f) as claimed in the instant invention as well as any combination or possibility of combining *Toona sinensis*

and *Heracleum lanatum* for interactively providing an elevated effect of treatment diabetes, arthritis and neuralgia.

9. “To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness...” *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991).

10. Accordingly, the applicant believes that neither Jones nor Yang et al, separately or in combination, suggests or makes any mention whatsoever of the difference subject features (a) to (f) as claimed in the amended claims 36 to 43 of the instant invention.

11. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

12. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

13. A total of thirty-nine claims, including thirty-one withdrawn claims and eight newly drafted claims, are presented. A check in an amount of US\$100.00 is submitted herewith to pay the additional filing fee of four additional claims in excess of thirty-five original presented claims. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 502111.

14. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 36-43 at an early date is solicited.



15. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 10/10/2006

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Person Signing: Raymond Y. Chan